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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,403

Applicant(s)

JOLITZ, RANDAL J.

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8 and 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Specification

The specification, as on page two, presents a brief description of a Figure 1 and a Figure 2, as well as referencing Figures 1 and 2 in the detailed description, when there appears no drawing sheets with the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5-8, and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 6 begin as by reciting “[a]n article comprising: a...roofing shingle...”. However, it is not understood as to what the article is directed if the article comprises a roofing shingle. In other words, is the article a body that includes a roofing material? Otherwise, what, specifically, is being defined by “...comprising a roofing shingle”?

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 5, 6, and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Bieser et al. Bieser et al. discloses a tile formed of a composition mixture of about 36 to 64% polyethylene and about 36 to 64% crushed limestone, col. 8, lines 8-45, the tile being less than an inch thick and between about 3-12 inches wide and between about 6-24 inches long, col. 11, lines 50-52.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(a) as being anticipated by Yamamoto et al. Yamamoto et al. discloses a tile formed of a composition mixture of about 36 to 64% polyethylene and about 36 to 64% crushed limestone, col. 4, lines 8-17 and col. 5, lines 22-24. The tile may be manufactured to any desired form and size.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieser et al. in view of the disclosure at lines 8-11 on page 1 of the instant specification.

Page 1 of the instant specification presents simulated shake and slate roofing or paneling as old and well known features within the building construction art. To have formed the Bieser et al. tile or sheeting of a simulated shake or slate appearance thus forming a tile or sheeting applicable to roofing or siding, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by the disclosure at lines 8-11 on page 1 of the instant specification.

6. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. in view of Bieser et al.

Arguments to each of Yamamoto et al. and Bieser et al. can be found above. To have formed the Yamamoto et al. tile of a size being less than an inch thick and between about 3-12 inches wide and between about 6-24 inches long, thus providing a tile of any specific form and size for any desired use or environment, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Bieser et al.

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7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al.

Yamamoto et al. teaches utilization of various fillers including andesite, granite, clay, silica, cinders, slag, among other fillers such as limestone. To have formed the Yamamoto et al. tile with fillers of either slate or shale, thus realizing the properties afforded by utilizing the well known slate or shale filling, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieser et al. in view of either Yamamoto et al. or Wells.

Yamamoto et al. teaches utilization of various fillers within the formed tile including andesite, granite, clay, silica, cinders, slag, among other fillers such as limestone. Wells teaches utilization of various fillers within the formed tile including clay, ash, talc, slate, and shale, among other fillers such as limestone. To have formed the Bieser et al. tile with fillers of either slate or shale, thus realizing the properties afforded by utilizing slate or shale filling, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by either Yamamoto et al. or Wells.

9. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. in view of the disclosure at lines 8-11 on page 1 of the instant specification.

Page 1 of the instant specification presents simulated shake and slate roofing or paneling as old and well known features within the building construction art. To have formed the Yamamoto et al. tile or sheeting of a simulated shake or slate appearance thus forming a tile or sheeting applicable to roofing or siding, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by the disclosure at lines 8-11 on page 1 of the instant specification.

10. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. in view of Bieser et al. as applied to claims 6 and 14 above, and further in view of the disclosure at lines 8-11 on page 1 of the instant specification.

Page 1 of the instant specification presents simulated shake and slate roofing or paneling as old and well known features within the building construction art. To have formed the modified Yamamoto et al. tile or sheeting of a simulated shake or slate appearance thus forming a tile or sheeting applicable to roofing or siding, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by the disclosure at lines 8-11 on page 1 of the instant specification.

Response to Arguments

Applicant's arguments filed January 21, 2004, have been fully considered but they are not persuasive. Applicant argues that Yamamoto et al. does not disclose a "roofing shingle". However, the presently rejected claims are directed to a stock material

per se with "roofing shingle" not serving to define over what is disclosed by Yamamoto et al. Minus any specifically recited structural feature which is not disclosed by Yamamoto et al. the language of those claims rejected under Yamamoto et al. does not serve to define any structure patentable thereover. It has been noted that the claim language has been amended to define an "article", (stock material), in general. As for the rejections involving Yamamoto et al. alone or in view of Bieser et al., the office action has set forth a motivation, in each instance. With regard to claims 7 and 8, forming the Yamamoto et al. tile with fillers of either slate or shale would produce a tile possessing the properties afforded by utilizing well known slate or shale filling. With regard to claims 6 and 14, Bieser et al. teaches various sizes for various applications thus, forming the Yamamoto et al. tile of any specific form and size for any desired use or environment, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Bieser et al., (note, for example, the last few lines of the Yamamoto et al. abstract). Applicant appears to allege that no motivation has ever been given for the proposed modifications involving Yamamoto but, as can be seen in the above rejections, all proposed modifications recite a motivation statement with regard to why one would produce each respective modification.

As for the rejections involving Bieser et al., and with respect to Applicant's reference to the Declaration of Stan Frankoski, Bieser et al. discloses a tile or stock material of a polyethylene composition. The ethylene/alpha-olefin interpolymer of Bieser et al. does read upon polyethylene as is accepted in the art. See, for example, U.S. patent no. 4,508,842 which discloses, as at col. 2 to col. 3, forming a polyethylene of an

ethylene/alpha-olefin interpolymer. Hawley's Condensed Chemical Dictionary notes that ethylene may be copolymerized with varying percentages of other materials, listing as examples an alpha-olefin including propylene and 2-butene, to develop an accepted form of a polyethylene. Ramesh et al. discloses homogeneous interpolymers and cites as examples EXACT of Exxon Chemical Co., TAFMER of Mitsui Petrochemical Corp., and AFFINITY of Dow Chemical Co., col. 6, lines 42-56. Pozniak et al., as at lines 35-37 of col. 8, Nelson et al., as at lines 29-35 of col. 6, and Keilman et al., as at col. 7 to col. 8, disclose each of AFFINITY, EXACT, and TAFMER respectively, as polyethylene exhibiting the same properties as the Bieser et al. polyethylene composition, (see col. 2, line 29, col. 3, lines 22-30, and col. 4, lines 8-15 and 38-50 of Bieser et al.). Bieser et al., therefore serves to read upon "polyethylene" as is recited within the instant claims. To this end, the Frankoski Declaration states that the ethylene/alpha-olefin interpolymer of the Bieser et al. polyethylene composition is not the claimed polyethylene. However, the instant claims do not set forth any specific polyethylene composition and no specific polyethylene composition is presented within the instant specification.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
May 12, 2004